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Thiru Srinivasan

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EXAMINER

ALVAREZ, RAQUEL

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* THIRU SRINIVASAN and WILLIAM WHITE
9

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11 Appeal 2009-004353
12 Application 10/001,662
13 Technology Center 3600
14

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16 Decided: August 19, 2009
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19 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH
20 A. FISCHETTI, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

STATEMENT OF THE CASE

Thiru Srinivasan and William White (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-6, 8-11, and 22-25, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION¹

We AFFIRM.

THE INVENTION

The Appellants invented a method and apparatus which provides for the selective transmission of multimedia information to particular members of an audience according to demographic information. Specification 1:12-15.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of transmitting multimedia from a network server information over a data network comprising the steps of:

[1] detecting at least one system user logged into a network server through a connection established over the data network from a remotely located computer and identifying an IP address

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed March 14, 2008) and the Examiner's Answer ("Ans.," mailed May 28, 2008), and Final Rejection ("Final Rej.," mailed August 11, 2006).

1 associated with the connection of the remotely located
2 computer with the network server, and presenting one or more
3 hypertext links which are selectable so as to view a selected
4 multimedia presentation;
5 [2] receiving through a screen display demographic
6 information for the at least one system user;
7 [3] using the IP address to access at least one database to
8 retrieve demographic information stored therein associated with
9 the at least one system user;
10 [4] based on the selected hypertext link accessing the
11 selected multimedia presentation in a computer memory and
12 transmitting the selected multimedia presentation information
13 from the network server of the connection to the remotely
14 located computer;
15 [5] detecting an inserted commercial break during the
16 transmission of the multimedia presentation over the
17 connection;
18 [6] based on the demographic information associated with
19 the at least one system user, accessing a commercial database
20 and retrieving at least one commercial associated with the
21 demographics for the at least one system user; and
22 [7] transmitting the retrieved commercial to at least one
23 system user over the connection during the commercial break.
24

25 THE REJECTIONS

26 The Examiner relies upon the following prior art:

Wachob	US 5,155,591	Oct. 13, 1992
Rangan et al.	US 6,006,265	Dec. 21, 1999

27
28 Claims 1-6, 8-11, and 22-25 stand rejected under 35 U.S.C. § 103(a) as
29 being unpatentable over Rangan and Wachob.

ARGUMENTS

Claims 1-6, 8-11, and 22-25 rejected under 35 U.S.C. § 103(a) as being unpatentable over Rangan and Wachob

The Appellants argue these claims as a group.

Accordingly, we select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Examiner found that Rangan describes all of the limitations of claim 1, except for limitation [5]. Ans. 3-4. The Examiner found that Wachob describes limitation [5]. Ans. 4. The Examiner found that a person with ordinary skill in the art would have recognized the benefit of facilitating the scheduling of commercial breaks by detecting when a commercial break is approaching. Ans. 4. The Examiner further found that a person with ordinary skill in the art would have found it obvious to combine Rangan and Wachob. Ans. 4.

The Appellants contend that:

(1) Rangan fails to describe limitation [2] of claim 1 (App. Br. 13-14);

(2) Rangan fails to describe the insertion of commercials based on demographic information, as required by limitations [6] and [7] of claim 1 and the Appellants' arguments are not attacking the references separately (App. Br. 14);

(3) Wachob fails to describe limitation [5] (App. Br. 16);

(4) There is no motivation to combine Rangan and Wachob and Wachob is not analogous art (App. Br. 16-17);

(5) The Examiner should have issued a third non-final office action after failing to address claims 2, 4, and 9-11 in the second non-final office action (App. Br. 17-18);

(6) Dependant claims 2-3, 5-6, 8, and 10 are allowable for the same reasons as discussed for claim 1 (App. Br. 18);

(7) Rangan fails to describe the limitations of claim 4 (App. Br. 18-19);

(8) Wachob fails to describe an ad hoc commercial break as per claim 5 (App. Br. 19);

(9) Rangan and Wachob fail to describe claim 9 (App. Br. 20);

(10) Rangan and Wachob fail to describe receiving a login ID from a system user as per claim 11 (App. Br. 21); and

(11) Rangan, Wachob, and the Examiner's Official Notice fail to describe a schedule database stores one or more screen displays which are presentable and through which the system users enter demographic information, as per claims 22-25. App. Br. 21-22.

ISSUES

The issue pertinent to this appeal are whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-6, 8-11, and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over Rangan and Wachob. The pertinent issue turns is whether Rangan and Wachob describe all of the limitations of claims 1, 4, 5, 9, 11, and 22-25 and whether there is a motivation to combine the cited references.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Rangan

01. Rangan is directed to the streaming of digital video or hypervideo to end users. Rangan 1:32-39. Hypervideo can be defined as a combination of digital video and hypertext, which is the combination of digital video with a polyvocal linked text. Rangan 2:35-38.
02. A hypervideo is sent from a hypervideo server to one or more client viewers as a multicast. Rangan 10:28-33. Hyperlinks, which are connections to related content such as static pictures, texts, sounds, URLs, and other video sequences (Rangan 5:28-35), are inserted into the hypervideo and are directed to a suitable demographic audience. Rangan 10:28-47. For example, when a user who is from a poor demographic or a tendency against consumption selects a hyperlink for a Ford car, he is presented with an advertisement for a less expensive Ford automobile. Rangan 11:4-8.
03. The system further maintains statistics on all of the links or items that a user clicks through in the hypervideo, including on-line purchases, submissions, and expressions of interest. Rangan 29:32-39. The system uses the unique identity of an individual to dictate the customization of the hypervideo transmitted to that

1 user. Rangan 8:3-10. The server receives identification
2 information, such as the client identification, to invoke the
3 appropriate hyperlinks or subprograms. Rangan 25:52-55. Based
4 on the click through feedback, subsequent on-the-fly commercial
5 insertions may be tuned to local demographic conditions or user
6 profiles. Rangan 20:52-60.

7 *Wachob*

8 04. Wachob is directed to the provision of different commercial
9 messages to different demographically targeted cable television
10 audiences. Wachob 1:7-10.

11 05. In operation, prior to making any function available to a user,
12 the user inputs demographic information using switches and the
13 remote control. Wachob 5:61-65. The switches can be used to
14 indicate demographic information, such as whether the user is an
15 adult male or female. Wachob 5:45-47. The system stores the
16 demographic information such that the system is aware of the
17 demographic information for the user current watching the
18 television. Wachob 5:65-67.

19 06. Television program channels and commercial channels are
20 transmitted to the television converter. Wachob 6:26-29. The
21 system detects when a commercial break is about to occur.
22 Wachob 6:29-31. Once a commercial break is detected, the
23 converter identifies the demographic characteristics of the current
24 viewer and tunes the television to the appropriate commercial
25 channel based on the demographic information. Wachob 6:47-54.

1 Upon the completion of the commercial, the converter returns to
2 the original channel. Wachob 6:54-59.

3 *Facts Related To The Level Of Skill In The Art*

4 07. Neither the Examiner nor the Appellants have addressed the
5 level of ordinary skill in the pertinent arts of targeted marketing
6 and video content programming. We will therefore consider the
7 cited prior art as representative of the level of ordinary skill in the
8 art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir.
9 2001) (“[T]he absence of specific findings on the level of skill in
10 the art does not give rise to reversible error ‘where the prior art
11 itself reflects an appropriate level and a need for testimony is not
12 shown’ ”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys.*
13 *Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

14 *Facts Related To Secondary Considerations*

15 08. There is no evidence on record of secondary considerations of
16 non-obviousness for our consideration.

17 PRINCIPLES OF LAW

18 *Obviousness*

19 A claimed invention is unpatentable if the differences between it and
20 the prior art are “such that the subject matter as a whole would have been
21 obvious at the time the invention was made to a person having ordinary skill
22 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550
23 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

24 In *Graham*, the Court held that that the obviousness analysis is
25 bottomed on several basic factual inquiries: “[1] the scope and content of

1 the prior art are to be determined; [(2)] differences between the prior art and
2 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
3 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at
4 406. “The combination of familiar elements according to known methods is
5 likely to be obvious when it does no more than yield predictable results.” *Id.*
6 at 416.

7 ANALYSIS

8 *Claims 1-6, 8-11, and 22-25 rejected under 35 U.S.C. § 103(a) as being*
9 *unpatentable over Rangan and Wachob*

10 The Appellants first contend that (1) Rangan fails to describe the
11 entering of demographic information through a screen display as required by
12 limitation [2] of claim 1. App. Br. 13-14. We disagree with the Appellants.
13 Limitation [2] requires that demographic information is received through a
14 screen display. Rangan describes the use of demographic information used
15 for targeted marketing purposes. FF 02. Rangan further describes the use of
16 information that a user inputs by clicking through hyperlinks presented to a
17 user on a display. FF 02-03. This preference information is saved to the
18 user’s profile and is used in combination with demographic information to
19 determine the type of commercials to be presented to the user. FF 02-03.
20 The combination of this input information and demographic information
21 suggests that the demographic information is received through the user’s
22 input. Furthermore, Wachob clearly describes that a user is required to input
23 demographic information using a remote control or switches before any
24 content is transmitted to the user. FF 05. As such, Rangan and Wachob
25 describe limitation [2] of claim 1.

1 The Appellants additionally contend that, (2) Rangan fails to describe
2 the insertion of commercials based on demographic information as required
3 by limitations [6] and [7] of claim 1 and the Appellants' arguments are not
4 attacking the references separately. App. Br. 14. The Appellants
5 specifically contend that, Rangan's description of inserting hyperlinks is
6 different from the insertion of commercials. App. Br. 14.

7 We disagree with the Appellants. Rangan describes the use of
8 demographic information for targeted marketing purposes as discussed
9 *supra*. Ragan further describes the use of statistical information and
10 demographic information in order to determine which commercial to be
11 inserted with hyperlinks into the hypervideo. FF 02-03. The hyperlinks
12 connect the user to relevant content, including commercials. FF 02. That is,
13 Rangan describes determining which commercial to link the user based on
14 the demographic information of the user. As such, Rangan describes the
15 insertion of hyperlinks, which direct a user to targeted commercials, based
16 on demographic information as required by limitations [6] and [7]. The
17 Appellants also contend that the Appellants' arguments are not attacking the
18 references separately and the Examiner has improperly applied *In re Keller*.
19 App. Br. 15-16. The Examiner has cited *In re Keller*, 642 F.2d 413, (CCPA
20 1981), in response to other contentions presented by the Appellants, which
21 are discussed in more detail *infra*.

22 The Appellants also contend that (3) Wachob fails to describe limitation
23 [5]. App. Br. 16. We disagree with the Appellants. Limitation [5] requires
24 the detection of a commercial break during the transmission of a multimedia
25 presentation. Wachob describes providing a plurality of channels that
26 contain content channels and commercial channels. FF 06. Using tags, the

1 converter detects whether a commercial break is imminent and prepares to
2 tune to the appropriate commercial channel at the detection of an imminent
3 commercial break. FF 06. As such, Wachob explicitly describes limitation
4 [5].

5 The Appellants further contend that (4) there is no motivation to
6 combine Rangan and Wachob, and Wachob is not analogous art. App. Br.
7 16-17. We disagree with the Appellants. Rangan is concerned with the
8 transmission of digital video with hyperlinks to commercials that are
9 customized for the user. FF 01. Rangan accomplishes this by inserting
10 hyperlinks to related content, such as commercials, that are targeted to a
11 specific audience based on the demographics or preferences of that audience.
12 FF 02-03. Wachob is also concerned with targeted marketing in television
13 content. FF 04. Wachob accomplishes this by detecting a commercial break
14 in the video content and tuning a television to a commercial channel based
15 on the previously entered demographic information of the user. FF 05-06.
16 A person of ordinary skill in the art would have recognized the benefit in
17 seamlessly presenting a commercial to a user at the time of a commercial
18 break, thereby enhancing the user experience by implementing the features
19 of detecting an imminent commercial break and presenting a tailored
20 commercial to the user during the commercial break. Since both references
21 are concerned with the presentation of customized information and
22 commercials to a user during the presentation of video content while
23 customizing the commercials presented to a user based on demographic
24 information, Rangan and Wachob are analogous arts. The presentation of
25 content with customized commercials demonstrates that both references
26 attempt to solve the same problem regardless if the mere method of

1 transmission (analog or digital) is different, as contended by the Appellants.
2 App. Br. 16. As such Rangan and Wachob are concerned with solving the
3 same problems and a person with ordinary skill in the art would have been
4 lead to combine their teachings.

5 The Appellants further contend that (5) the Examiner should have issued
6 a third non-final office action after failing to address claims 2, 4, and 9-11 in
7 the second non-final office action. App. Br. 17-18. However, this relates to
8 a petitionable matter and not to an appealable matter. See *In re Schneider*,
9 481 F.2d 1350, 1356-57. (CCPA 1973) and *In re Mindick*, 371 F.2d 892,
10 894. (CCPA 1967). Thus, the relief sought by the Appellants would have
11 been properly presented by a petition to the Commissioner under 37 C.F.R. §
12 1.181, instead of by appeal to this Board. Accordingly, we will not further
13 consider this issue.

14 The Appellants also contend that (6) dependant claims 2-3, 5-6, 8, and
15 10 are allowable for the same reasons as discussed for claim 1 *supra* (App.
16 Br. 18). The Appellants rely on their arguments in support of claim 1 *supra*,
17 which we did not find to be persuasive *supra* and do not find to be
18 persuasive here for the same reasons discussed *supra*.

19 The Appellants contend that (7) Rangan fails to describe the limitations
20 of claim 4. App. Br. 18-19. We disagree with the Appellants. Claim 4
21 requires a step of, monitoring a user and accumulating additional
22 demographic information for a multimedia presentation. As discussed
23 *supra*, Rangan describes collecting and storing click-through information for
24 a user during a hypervideo presentation. FF 05-06. That is, Rangan
25 maintains statistics regarding the preferences for a user and combines them
26 to already collected demographic information in order to customize the user

1 experience. As such, Rangan describes the steps of monitoring a user's click
2 through activity and accumulating demographic information, as required by
3 claim 4.

4 The Appellants also contend that, (8) Wachob fails to describe an ad hoc
5 commercial break, as per claim 5. App. Br. 19. We disagree with the
6 Appellants. The Examiner relied on Rangan to describe an ad hoc
7 commercial break. Rangan describes that commercials can be inserted on-
8 the-fly based on demographic information and user profiles. FF 03. On-the-
9 fly commercials are ad hoc commercials. As such, Rangan describes claim
10 5. The Appellants argument that Wachob fails to describe claim 5 is not
11 found persuasive because the Examiner has not relied on Wachob to
12 describe claim 5.

13 The Appellants are responding to the rejection by attacking the
14 references separately, even though the rejection is based on the combined
15 teachings of the references. Nonobviousness cannot be established by
16 attacking the references individually when the rejection is predicated upon a
17 combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d
18 1091, 1097. (Fed. Cir. 1986).

19 The Appellants further contend that, (9) Rangan and Wachob fail to
20 describe claim 9. App. Br. 20. We disagree with the Appellants. Claim 9
21 requires a step to query a user for demographic information when the user
22 logs on to the system. Wachob describes that a user must enter demographic
23 information prior to accessing the video content. FF 05. The user enters this
24 information using a remote control and a plurality of switches. FF 05. For
25 example, a switch can be associated to gender data and the user can use the
26 switch to indicate whether the user is an adult male or female. FF 05. That

1 is, Wachob requires that a user be queried for demographic information prior
2 to using the system. As such, Wachob describes the limitations of claim 9.
3 The Appellants' contentions that Rangan fails to describe these limitations is
4 not persuasive because the Examiner has not relied on Rangan to describe
5 these features. Nonobviousness cannot be established by attacking the
6 references individually when the rejection is predicated upon a combination
7 of prior art disclosures. *Id.*

8 The Appellants also contend that, (10) Rangan and Wachob fail to
9 describe receiving a login ID from a system user as per claim 11. App. Br.
10 21. We disagree with the Appellants. Rangan describes managing the
11 statistics and demographics for a user based on the stored user's click
12 through information. FF 03. The system associates this information to an
13 individual's unique identity. FF 03. The system further identifies the user's
14 activity based on the user's client identification. FF 03. That is, Rangan
15 associates data to a specific user and monitors that user's activity based on
16 the presence of a user's specific identification information. As such, Rangan
17 describes receiving a login ID. The Appellants' contentions that Wachob
18 fails to describe these limitations is not persuasive because the Examiner has
19 not relied on Wachob to describe these features. Nonobviousness cannot be
20 established by attacking the references individually when the rejection is
21 predicated upon a combination of prior art disclosures. *Id.*

22 The Appellants further contend that, (11) Rangan, Wachob, and the
23 Examiner's Official Notice, fail to describe a schedule database that stores
24 one or more screen displays which are presentable and through which the
25 system users enter demographic information, as per claims 22-25. App. Br.
26 21-22. We disagree with the Appellants. The Examiner has taken Official

1 Notice of the fact that, to store schedule information for an event is
2 notoriously old and well-known in the art. The Examiner has further relied
3 on Rangan and Wachob to describe receiving demographic information
4 entered through a screen display, as discussed *supra*. As such, the
5 Appellants' contention that the Official Notice was sufficiently traversed by
6 challenging the fact that it is well-known to store screen display information
7 is not found persuasive because the Examiner has not relied on Official
8 Notice to describe this feature. Since the Examiner has only taken Official
9 Notice of the fact that, to store schedule information for an event is well-
10 known, the Appellants are effectively attacking the references individually,
11 which cannot be used to establish nonobviousness. *Id.*

CONCLUSIONS OF LAW

14 The Appellants have not sustained their burden of showing that the
15 Examiner erred in rejecting claims 1-6, 8-11, and 22-25 under 35 U.S.C.
16 § 103(a) as being unpatentable over Rangan and Wachob.

DECISION

19 To summarize, our decision is as follows.

- 20 • The rejection of claims 1-6, 8-11, and 22-25 under 35 U.S.C. § 103(a)
21 as being unpatentable over Rangan and Wachob is sustained.

